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FROM: J. Derel Monteith, Jr., Esq.

RE: Application of Van H. Brown; Application No. 10/661,201
Filed: November 12, 2003
For: Pet Chew Toy

REMARKS: See attached Response to Petition for Access.

NO. OF PAGES: 20 including cover page

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Brown, Van H.)
Application Serial No. 10/661,201)
Filed September 12, 2003¹)
For: Pet Chew Toy)

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**APPLICANT'S RESPONSE IN OPPOSITION TO 37 C.F.R. § 1.14(h) PETITION FOR
ACCESS TO APPLICATION**

Applicant Van H. Brown ("Applicant") hereby responds in opposition to the Petition for Access filed by Michael Brooks on behalf of Christopher Alan Weinberg ("Petitioner") on February 27, 2004. As discussed further below and in the attached declaration from Applicant (Declaration of Van H. Brown, attached hereto as Exhibit 1; hereinafter "Applicant Decl."), Petitioner is neither an inventor nor an owner relative to the above-referenced application, and no "special circumstances" exist that warrant granting Petitioner access to the application. See 37 C.F.R. § 1.14(h). Therefore, Applicant urges the U.S. Patent & Trademark Office ("the Patent Office") to deny the petition.

I. INTRODUCTION

As a starting point, it is critical to maintain an awareness of the courts' strict views regarding secrecy of pending, unpublished nonprovisional patent applications:

Patent applications are preserved in secrecy by both law, 35 U.S.C. § 122, and regulation, 37 C.F.R. § 1.14, for a reason. The integrity of the patent system is maintained in part by inventors' understanding that their patent applications will remain secret until either the patents issue or the applications are otherwise published by the PTO. Breaches of this secrecy undermine the integrity of the patent system. When these breaches occur under a court's watch, sanctions are wholly appropriate. To the extent that the district court did not impose sanctions in this instance, we hold that it abused its discretion.

¹ Applicant respectfully notes that the Three Week Letter mailed to Schwartz Law Firm, P.C., Applicant's primary prosecution counsel, regarding the petition at issue erroneously listed the filing date of the application as November 12, 2003 instead of September 12, 2003, the correct filing date.

Eagle Comtronics, Inc. v. Arrow Communication Laboratories, Inc., 305 F.3d 1303, 1314 (Fed. Cir. 2002). Therefore, in order to be granted, petitions for access to patent applications currently held in strict secrecy by the Patent Office must be supported by either an Act of Congress—no small hurdle to overcome—or “special circumstances,” a standard that should provide an equally difficult barrier to gaining access. See 37 C.F.R. § 1.14(h).

II. NO CO-OWNERSHIP AGREEMENT HAS EVER COME TO FRUITION BETWEEN PETITIONER AND APPLICANT AND PETITIONER HAS FAILED TO MAKE ANY SHOWING TO THE CONTRARY

Although Petitioner makes vague references to a “joint venture” with Applicant and summarily concludes that he “jointly owns” the intellectual property created for the “joint venture,” Petition at 2, Petitioner completely fails to substantiate his claims. In fact, Petitioner’s joint ownership claims are mere attorney argument, as they are not even mentioned in his own declaration. More specifically, Petitioner has produced no written agreement between himself and Applicant and has not, beyond the aforementioned attorney argument, even described the terms of whatever agreement he believes to exist. Such meager support for co-ownership does not even constitute the proof of ownership necessary to request the status of a pending, unpublished nonprovisional application, much less to receive full disclosure of the prosecution history of such an application. See 37 C.F.R. § 3.73(b) (requiring documentary proof of ownership or a statement of where such proof is recorded in the assignment records of the Patent Office); MPEP §§ 102, 324.

The reality of the history between Petitioner and Applicant is as follows, which is stated in greater detail in the attached declaration from Applicant (Exhibit 1). Petitioner and Applicant attempted to form a business relationship with one another and at one point they planned to transfer whatever patents would issue to cover the new pet chew toy invented by Applicant to a

corporate entity called Blast Bros., LLC to be established and co-owned by Petitioner and Applicant. However, no such relationship or agreement ever came to fruition. See Applicant Decl. ¶¶ 8, 9.

The collapse of business relations between Petitioner and Applicant came as a result of Petitioner's repeated disavowal of Applicant's understanding of the terms governing such relations. For instance, Applicant understood that he and Petitioner would share the commodity products available to manufacture the pet chew toys; however, in the midst of their exhibit at a pet product trade show, Petitioner refused to share such a product with Applicant. See id. Further, although Applicant singlehandedly acquired some thirteen documents necessary to clear a container of meat jerky manufactured in the U.S. for shipment to China to be used in the assembly of the pet treats, and although Applicant understood that Petitioner would pay Applicant a portion of the proceeds from Petitioner's sales of the multiple containers of finished pet treats incorporating such jerky, Petitioner has never made any payment whatsoever to Applicant. See id. Finally, although Applicant understood that an entity called Blast Bros., LLC was to be established to own the business being formed by Petitioner and Applicant, see id., Petitioner has apparently filed a certificate with the California Secretary of State to cancel the Blast Bros., LLC entity he initially formed in California. See Exhibit 2 (printouts from website of California Secretary of State showing corporate status of Blast Bros., LLC as "pending cancel" and defining "pending cancel" status as meaning that a Certificate of Cancellation has been filed). For at least these reasons, no verbal attempts by Petitioner and Applicant to form a business relationship with one another ever came to fruition, no written agreement between Petitioner and Applicant was ever entered into, and no interest in the present application or the

underlying invention was ever assigned by Applicant to Petitioner, Blast Bros., LLC, or any other individual or entity. See Applicant Decl. ¶ 12.

Therefore, Petitioner is not a co-owner of the present application or the underlying invention and has failed to make any showing to the contrary, removing co-ownership as a potential basis for giving Petitioner access to the present application.

III. PETITIONER MADE NO CONTRIBUTION TO THE INVENTION CLAIMED IN THE APPLICATION AND PETITIONER HAS FAILED TO MAKE ANY SHOWING TO THE CONTRARY

“Conception is the touchstone of inventorship, and each joint inventor must contribute in some significant manner to the conception of the invention. Conception is the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is applied in practice.” BJ Services Co. v. Halliburton Energy Services, Inc., 338 F.3d 1368, 1373 (Fed. Cir. 2003) (citations omitted). Petitioner made no such contribution to the conception of the invention claimed in the present application and fails to provide any proof to the contrary in his petition. Therefore, co-inventorship is likewise no potential basis for giving Petitioner access to the present application.

In stark contrast to Petitioner, Applicant, in the attached declaration, describes the technical knowledge and experience that led to his conception of the invention, and describes his actual conception of the invention in detail. See Applicant Decl. ¶ 6. Specifically, Applicant, using his Bachelor and Master of Science degrees in chemistry, has worked in the design and manufacture of animal and human food products for over twenty years, most recently including his founding, ownership, and operation of Carolina Prime Pet, a pet product design and manufacturing business established in 1997. See Applicant Decl. ¶ 3. Using this background, Applicant conceived the invention when, during a trip to China with Petitioner to arrive at new

products, Applicant observed the low-moisture method of porkskin treat preparation used by the Chinese and realized that this method would be ideal for incorporating the fragile but tasty cold-extruded jerky in the center of almost any configuration of treat. Adding to his conception was his awareness from his manufacturing experience with porkskin that the skin itself could be flavored and/or provided with an external coating to further enhance the product. See id.

Applicant presented the result of his conception to Petitioner during their China trip and Petitioner's immediate reaction was that he hoped Applicant would allow Petitioner to sell treats made according to the invention. See Applicant Decl. ¶ 7. This inventor/salesman dichotomy between Applicant and Petitioner defined their relationship. For instance, Petitioner's primary product ideas during his trip to China with Applicant merely involved having a Chinese manufacturer replicate pet products already patented and marketed by third parties in the United States. See Applicant Decl. ¶ 6. In fact, to the best of Applicant's knowledge, Petitioner owns and operates merely a pet product brokerage business without engaging in design or manufacturing, as Applicant provided all the design and manufacturing information used by Petitioner and Applicant during their relationship. See Applicant Decl. ¶ 4. Furthermore, Petitioner repeatedly indicated to Applicant that Petitioner wished he was creative and that if Applicant could create new products, Petitioner could sell them. See id. Petitioner's submissions to the Patent Office do not include any material showing to counterbalance the overwhelming evidence of Applicant's conception and Applicant's primarily inventive role in his relationship with Petitioner.

Some confusion regarding inventorship may exist as a result of Petitioner's inclusion as an inventor on the provisional patent application to which the present nonprovisional application claims priority. However, this inclusion comes only as a result of an inadvertent mistake of law

by Applicant. As Applicant indicates in his declaration, in reaction to Petitioner's request to sell products embodying the invention, without having any knowledge of the requirements for inventorship under U.S. patent law, Applicant told Petitioner that Applicant would "put [Petitioner] on the patent." See Applicant Decl. ¶ 7. In keeping with this statement, when Applicant's primary patent prosecution counsel, Jeff Schwartz, asked Applicant for the names of the inventors to list on the provisional application, Applicant told Mr. Schwartz to list himself and Petitioner. See id. However, when the time to file the present nonprovisional application and Mr. Schwartz questioned Applicant regarding inventorship, Applicant's mistake of law became clear and Mr. Schwartz determined that in light of Applicant's conception of the invention being claimed in the nonprovisional application, and the lack of any inventive contributions from Petitioner, Applicant had to be listed as the sole inventor on the application. See Applicant Decl. ¶ 11. Thus, no weight should be given to the mistaken inclusion of Petitioner as an inventor on the provisional application to which the present application claims priority.

In light of Applicant's solitary conception of the claimed invention and Petitioner's failure to provide any material showing of any contribution to conception, no co-inventorship of the invention claimed in the present application has been proven by Petitioner, removing co-inventorship as a potential basis for allowing Petitioner to gain access to the present application.

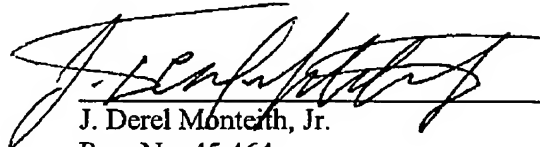
IV. CONCLUSION

In sum, Petitioner has failed to make anything approaching a showing sufficient to constitute "special circumstances" that would warrant a violation of the strict secrecy of the present application, a secrecy that the law rightly and vigorously protects. Without such secrecy, Applicant believes that significant financial damage may be caused to him and his business by

forcing him and his business to further contest whatever spurious claims Petitioner might make to the application, the underlying invention, and proceeds from sales of products embodying the invention. See Applicant Decl. ¶ 13. Therefore, the Patent Office should deny the petition.

DATE: April 15, 2004

Respectfully submitted,



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